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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,794	12/01/2000	Lynn T. Rowe	98,597-B	3095

7590 12/17/2004

McDonnell Boehnen Hulbert & Berghoff  
Suite 3200  
300 South Wacker Ddrive  
Chicago, IL 60606

EXAMINER
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TRAN, HAI V

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/728,794

Applicant(s)

ROWE ET AL.

Examiner

Hai Tran

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/18/01.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I, Claims 1-12, drawn to Information Distribution system delivering digital programs with a multi-screen display and GUI, classified in class 345, subclass 327.

Group II, Claims 13 -14, drawn to Interactive Information distribution system with a return network and a purchasing feature, classified in class 348, subclass 12.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as Interactive product purchasing in other environments such as computer networks. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with George Lee on 12/09/2004 a provisional election was made without traverse to prosecute the invention of group II, claims 13-14. Affirmation of this election must be made by applicant in replying to this Office action.
5. Claims 1-12 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birch et al. (US 5583562) in view of Townsend et al. (US 2003/0009758).

Claim 13, Birch discloses an interactive information distribution system delivering digital program information over a large geographic area wherein the digital program information provides different broadcast quality TV programming to a plurality of remote locations within the geographic area (Fig.1), the system comprising:

a network operations center (100) creating national programming and multiplexing interactive programming to create a digital interactive streaming media (Col.5, lines 13-42).

a distribution system transmitting the digital interactive streaming media to the plurality of remote locations (150) (Col.5, lines 49-67);

Birch does not disclose a set top application system to develop the interactive programming to be displayed to viewers, wherein the interactive programming is carried by the digital streaming media and enables viewer to select displayed items for purchase, and a return network to communication transactional information from the remote location to provide interactive programming capability.

Townsend discloses the interactive programming is carried by the digital streaming media received at remote receiver and enable viewer to select displayed items for purchase (Fig. 5-11; see sections 0053,0055) and a return network to communication transactional information from the remote location to provide interactive programming capability (section 0066-0067). As to the limitation "a set top application system to develop the interactive programming to be displayed to viewers", Townsend does not mention about it. However, this limitation is inherent because Townsend received interactive TV signal representing both image data and information data, as described in section 0013 and page 3, section 0050-0053, in which Townsend describes as interactive menu template (see sections 0050-0052 of page 4; page 5, section. 0064). These interactive menu templates must be generated by some type of application software (set top application system), i.e., authored tool, so that Townsend 's system could perform as disclosed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Birch with Townsend so to provide to user a wide range of available interactive services, i.e., online shopping, in which the system could

establish a telecommunication link to a remote site for online transfer of data therewith in response to the selection of services (section 0013-0014).

Claim 14, Townsend further discloses wherein the interactive programming offers services for purchase from commercial providers (sections, 00114, 0066, and 0069).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is 703-308-7372. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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HT:ht

12/06/2004

A handwritten signature in cursive script, appearing to read "HAITRAN", is written over two parallel horizontal lines.

HAITRAN  
PATENT EXAMINER